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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,612	09/15/2003	Patrick J. Coyne	0005-0005	9305
36878 7590 08/19/2008 MH2 TECHNOLOGY LAW GROUP, LLP 1951 KIDWELL DRIVE SUITE 550 TYSONS CORNER, VA 22182				
EXAMINER				
PARDO, THUY N				
ART UNIT		PAPER NUMBER		
2168				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,612

Applicant(s)

COYNE ET AL.

Examiner

Thuy N. Pardo

Art Unit

2168

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/30/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-25 and 29-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-25 and 29-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2008 has been entered.

Applicant's Amendment filed on October 12, 2007 in response to Examiner's Office Action has been reviewed. request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. This Office Action is Non-Final.

2. In the amendment filed June 30, 2008, claims 1-3, 7-25 and 29-55 are pending in the application. Claims 4-6 and 26-28 are canceled, claims 1, 12, 23, 34, 45 are amended. This Office Action is made Non-Final.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined

application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 7-25 and 29-55 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-118 of copending Application No. 10/315,196. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

subject matter, as follows: A system and method for managing data having different formats into a portable (i.e., common) format.

4. Applicant's Affidavit or Declaration Under 37 CFR 1.131 filed on June 30, 2008 to submit a declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. However, Applicant shows the facts of establishing reduction to practice as early as November 03, 1999 prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration from prior January 01, 2001 to December 10, 2001 (filing date of Provisional Application 60/337,158). Therefore, Applicant's declaration under 37 CFR 1.131 is appropriate to overcome the rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(c) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, 7-25 and 29-55 are rejected under 35 U.S.C. 102(c) as being anticipated by Calow US Paten No. 6,714,928.

As to claim 23, Calow teaches the invention substantially as claimed, comprising:

- a. maintaining data in a first software application in a first portable format [different servers in different formats (e.g., from a variety different vendors, fig. 5A];
- b. maintaining data in a second software application in a second format other than said first format [col. 11, lines 40-57];
- c. communicating the data from said first software application to a professional services project management application through a first server [1201 of fig. 12];
- d. communicating the data from said second software application to said professional services project management application through said first server means cooperating with said second server [1202 of fig. 12; embedded in the page generated by the server component, col. 4, lines 35-41]; and
- e. providing the data to the user through said professional services project management application [converted by the system into equivalent HTML and java script and downloaded to the user, ab; the page returned to the web client, col. 4, lines 35-381203-1206 of fig. 12; 1305 of fig. 13].

As to claims 1, Calow teaches the invention substantially as claimed. Calow further teaches said professional service practice management application further comprising an interface for communicating the data to the user [AIP, ODBC interface, Powersoft database interfaces, col. 11, lines 42-57; fig. 5B].

As to claims 12, 34 and 45, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 2, Calow teaches the invention substantially as claimed. Calow further teaches that said professional services project management application comprises a shareware application [col. 11, lines 24-31; order entry application, 1 of fig. 4A].

As to claim 3, Calow teaches the invention substantially as claimed. Calow further teaches that said professional services project management application comprises a Lotus Notes database [Sybase databases, Watcom database, dBASE database, oracle database, fig. 5A, 5B].

As to claims 13-15, 24, 25, 35-39 and 46-50, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 7, Calow teaches the invention substantially as claimed. Calow further teaches that said first software application is adapted to maintain data selected from the group consisting of: docketing, word processing, Notes database, document management, email,

records, forms, workflow, conflicts, expense, budgeting, risk management, project management, database, imaging, and reporting data [choose from a variety of applications, fig. 4B, 4C, 8A-10B].

As to claims 8-11, Calow teaches the invention substantially as claimed. Calow further teaches that said second software application is adapted to maintain data selected from the group consisting of: accounting, time, billing, expense, cost, and budgeting data, accounting data, or a TMC accounting system [fig. 4B, 4C, 8A-10B].

As to claims 18-22, 29-33, 40-44 and 51-55, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 7-25 and 29-55 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy N. Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy N. Pardo/
Primary Examiner, Art Unit 2168